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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MARTIN PHILIP USHER  
and ANDREW ROBERT MEAD

Appeal 2009-003332  
Application 10/069,100  
Technology Center 2600

Oral Hearing Held: August 12, 2009

Before KENNETH W. HAIRSTON, JOHN C. MARTIN and BRADLEY W. BAUMEISTER, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

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The above-entitled matter came on for hearing on Wednesday, August 12, 2009, commencing at 9:00 a.m., at The U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Ashorethea Cleveland, Notary Public.

1 THE USHER: Good morning. Calendar 35, Appeal Number  
2 2009-3332. Mr. Watkins.

3 JUDGE HAIRSTON: Thank you.

4 MR. WATKINS: Good morning, Your Honors. Please forgive me.  
5 It's been many years since I have addressed the Board. So, if I'm wrong on  
6 protocol, it probably won't be my first mistake of the day.

7 JUDGE HAIRSTON: We're very informal.

8 MR. WATKINS: Thank you. My name is Scott Watkins. In this  
9 case, I think Stuart Huang was originally listed. He has retired. So, I have  
10 the honor of handling this one.

11 I wanted to start by giving a little bit more flavor to this case and its  
12 background than is really discussed in the paperwork.

13 The primary focus of the application as a whole is to get cell calls  
14 onto vehicles, particularly aircraft; and I'm going to limit my comments to  
15 aircraft just for ease of discussion.

16 We all know from aircraft and it's a very well publicized problem:  
17 How do we get cell calls up to the aircraft? They are usually out of range of  
18 cell towers. They're moving so fast that they are passing through cell zones  
19 so quickly you can't arrange the handoff to maintain the cell calls even if  
20 they were allowed which currently they are not.

21 Every prior-art reference tends to address this problem by creating a  
22 cell extension onto the aircraft. How do we put cell towers on the aircraft?  
23 How do we create the link so that the whole system can work even though  
24 the plane is moving?

25 Embodiments of this application take a very different approach to  
26 that. They are not trying to stay within the cell system. We are breaking out

1 of the cell system and the way we do that is when the cell comes on board  
2 you will register and the phone company will change your divert-on-busy  
3 instructions. That's when you don't answer or you're busy. You'll go to  
4 voicemail or another phone will ring.

5 What this system does, it says set the first priority, divert-on-business  
6 instruction to send it to a specialized aircraft system.

7 So, the phone rings and instead of going up to the aircraft it goes to  
8 the center which says, the phone is busy, whether it's on or off. It doesn't  
9 really matter. The phone is busy. Go to your diversion instructions. Your  
10 diversion instructions: Here's a phone number for the aircraft company. Go  
11 to the aircraft company's node and they will handle it through their separate  
12 satellite system to maintain communication with the phone.

13 So, no matter how high it goes or where it goes, you are no longer  
14 constrained by the cell system.

15 So, our method is not an extension of the cell system. It's a rerouting  
16 methodology that gets around it. The application is an end-to-end process  
17 on that.

18 Features of that which are relevant to this case, because we have  
19 several patents on this diversion methodology, is that you can turn this  
20 rerouting methodology off. There are a couple of examples in the  
21 application; but basically, plain just doesn't want to have the phone ring  
22 anymore. So, they press a button and a message will go down to whatever  
23 center it is and the interface that's handling this rerouting is told, don't do  
24 that anymore.

25 So, any more incoming calls that are going to go into the aircraft are  
26 blocked. So, no more phones ringing.

1           However, because it's a redirection methodology as opposed to an  
2     extension of the cell system, when you cut that cord that has no effect on  
3     what is the independent existence of the calls in progress. The calls have  
4     already been routed. You are affecting the routing methodology but you're  
5     not affecting the actual system.

6           This is a key difference between our inventions and the prior art, is  
7     that in these cell extension systems, they can cut the connection. Many  
8     planes and policies require that they do. But when they cut it, not only are  
9     you preventing calls from continuing to come in, you're cutting off  
10    communication, period. It dies. And that's the distinction in our context.

11          So, we have these independent claims that capture, in broad language,  
12    these concepts in one of suspending simultaneously all calls to all of the  
13    users on the aircraft. No more calls coming in to anybody.

14          But in the next claim limitation, the suspension has no effect on a call  
15    in progress. So, if you are talking, you will continue to talk. We all know  
16    different claims have slightly different ways of presenting it; but that is a  
17    core issue in each.

18          That's basically background. I'll pause for a second and see if there  
19    are any questions.

20          JUDGE HAIRSTON: Let's turn to column 14 of the Zicker reference,  
21    in particular, lines, roughly, about eight or nine to 16.

22          MR. WATKINS: Yes, sir. If I may have a moment, Your Honor.

23          JUDGE HAIRSTON: Sure. Start at nine; nine to about 16.

24          MR. WATKINS: Yes, sir. I just want to consult the drawings, if I  
25    may for a moment, Your Honor.

26          (Pause.)

1 MR. WATKINS: Yes, Your Honor.

2 JUDGE HAIRSTON: I read this patent to say that the pilot or  
3 stewardess in the back of the plane can switch this whole system off. At the  
4 same time, it leaves open the option of calls that are in progress to continue.

5 MR. WATKINS: Your Honor, I'm aware of the -- I read this and was  
6 reminded of the column 12 language, if I may refer the Court back to that  
7 which was cited by the Examiner in the Answer, and roughly 51 to 52,  
8 when -- and it talks about it when there's an incoming call.

9 But when this system is in passive mode, it specifically says that the  
10 radio telephones are prevented from transmitting. They can't operate. And  
11 it's difficult to reconcile that with "14" which to the extent you want to say  
12 it's optional; it doesn't have to be there.

13 But in the passive mode, as I understand it, in this system, the entire  
14 purpose is to maintain it at extremely low-power levels and consistent with  
15 column 12 it's not transmitting.

16 So, the position that we've taken on this, whether it's "12" or "14," is  
17 that the phone is not transmitting anything. You can't be maintaining a call  
18 in progress. You definitely move into a shutdown mode.

19 JUDGE HAIRSTON: It shuts down everyone but it also leaves open  
20 the possibility that if there's a call in progress, the call in progress would  
21 continue.

22 MR. WATKINS: And my response would be my question, Your  
23 Honor: How can a call in progress be maintained if the phone cannot  
24 transmit?

25 JUDGE HAIRSTON: I'm looking at what it says.

1 MR. WATKINS: I understand. When I read Zicker, it didn't strike  
2 me to be one of the best drafted --

3 JUDGE HAIRSTON: It's poorly written.

4 MR. WATKINS: Poorly written; and I didn't write it. So, I'm  
5 excused on that one.

6 JUDGE HAIRSTON: You and I wouldn't have done this.

7 MR. WATKINS: We wouldn't have done this; and this may be one of  
8 those simple occasions where it doesn't work and the patent attorney may  
9 have sat there and said, "Oh, gee, maybe we should make this optional." But  
10 as far as its operation, the thing is shut down.

11 JUDGE HAIRSTON: In column 12, it says, "a call directed towards  
12 or initiated by." So, that's incoming and outgoing.

13 MR. WATKINS: Mm-hum.

14 JUDGE HAIRSTON: And when you get to "14," it says it leaves  
15 open the possibility that the users who are transmitting at that time can  
16 continue transmitting.

17 MR. WATKINS: And my only response to that could be, Your  
18 Honor, it's inconsistent with column 12 which says when you are in passive  
19 mode it will refrain from transmitting, thus preventing the call. Not only is  
20 it incoming and outgoing, it can't operate.

21 JUDGE HAIRSTON: Well, he says, "passive mode with an option."  
22 So, it's a modified passive mode, I guess.

23 MR. WATKINS: I don't have a better answer, Your Honor, other  
24 than inconsistency. I would stand on the more specific column 12 language  
25 that it just doesn't work.

1           They're discussing optionally that it could do this. It doesn't say it can  
2 do it the other way and its own structure says it can't.

3           JUDGE HAIRSTON: Yeah. I --

4           MR. WATKINS: We're all talking the same language on this one.

5           JUDGE HAIRSTON: Yes.

6           MR. WATKINS: I don't think there's any question on that.

7           The problem we're having with Zicker, also, which is an excellent  
8 transition point, is: Isn't this simultaneously suspending without calls in  
9 progress?

10          We appealed this case because the Examiner for two straight office  
11 actions and even on page three of the Answer -- he himself concedes it  
12 doesn't have it; but he went through McConnell for it and said, okay, it's not  
13 there.

14          JUDGE HAIRSTON: Well, we all make mistakes.

15          MR. WATKINS: Yes. We all make mistakes, although on page three  
16 versus page six of the same answer, there's -- okay.

17          JUDGE HAIRSTON: We looked at the combination and to be real  
18 honest with you, we read McConnell and we threw up our hands on that.

19          MR. WATKINS: Yeah. I think the Examiner in his subsequent  
20 rationale is backing off that because  
21 McConnell -- we're only suspending one call momentarily while we figure it  
22 out, where it has to go. You can bring that into Zicker. We're not  
23 simultaneously shutting down anything.

24          So, clearly, the basis of the rejection which the Examiner wasn't really  
25 contesting anymore -- he didn't even respond to my argument. I think it's  
26 expressing the combination is not there.



1           So, it really trails back to what is Zicker saying and what is Zicker  
2     giving us?

3           The Examiner is pointing to, again, figure one and column 12 which I  
4     realize I misquoted in my Reply Brief. I put in a lower portion of column 12  
5     on that. I actually have the actual one, if you want it, just in case.

6           JUDGE HAIRSTON: Oh, no. We're fine. Thank you.

7           MR. WATKINS: Okay. And again, it's specific language of  
8     absolutely no transmission.

9           I have to acknowledge the column 14 discussion to be optional and I  
10    don't think we can explore that any more other than to go -- well, column 12  
11    says it can't work and column 14 at least implies another possibility but  
12    doesn't explain how we would do it.

13          I would submit that the more specific controls the generic in this  
14    environment; and if you agree with that, then this rejection can't stand.

15          Thank you. I'm done.

16          JUDGE HAIRSTON: Any questions?

17          JUDGE MARTIN: No.

18          JUDGE BAUMEISTER: No.

19          JUDGE HAIRSTON: Thank you, counsel.

20          MR. WATKINS: Thank you.

21          (Whereupon, at approximately 9:15 a.m., the proceedings were  
22    concluded.)